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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,742	01/23/2001	John Posey	BD46-17	2270

7590 07/31/2002

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217 Harbor View Lane
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EXAMINER

WHITE, CARMEN D

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,742

Applicant(s)

POSEY, JOHN

Examiner

Carmen D. White

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) * 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Oath/Declaration

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "being capable to" and "adapted to" throughout the claim. This language is not clear and makes it difficult to ascertain the scope of the claims. It makes it difficult to determine whether the system hardware/software actually performs the function that is followed by this claimed language.

Claim 1 recites the limitation "the accurate positions", "the golf course" and "the necessary operations" in lines 4 and 31. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites "adapted to". This language is not clear and makes it difficult to ascertain the scope of the claims. It makes it difficult to determine whether the system hardware/software actually performs the function that is followed by this claimed language.

Claim 2 recites the limitation "the class" and "the necessary operations" in lines 3 and 13. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites "being capable to" and "adapted to" throughout the claim. This language is not clear and makes it difficult to ascertain the scope of the claims. It makes it difficult to determine whether the system hardware/software actually performs the function that is followed by this claimed language.

Claim 3 recites the limitation "the accurate positions", "the golf course" and "the necessary operations" in lines 4, 5 and 33. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the perimeter", "the desired region", "the points", "the outline" "the data collection", "the manual disabling", "the electronically traced region", "the newly traced region", "the appropriate field", and "the associated region" in lines 8, 10-12, 14-15 and 17-18. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites "there is there another region" in lines 20-21. This is not clear. It appears to be a misprint.

Claim 5 recites "being capable to" and "adapted to" throughout the claim. This language is not clear and makes it difficult to ascertain the scope of the claims. It makes it difficult to determine whether the system hardware/software actually performs the function that is followed by this claimed language.

Claim 5 recites the limitation "the accurate positions", "the golf course" and "the necessary operations" in lines 4-5 and 33. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the perimeter", "the desired region", "the points", "the outline" "the data collection", "the manual disabling", "the electronically traced region", "the newly traced region", "the appropriate field", and "the associated region" in lines 43, 45-46, 47, 49 and 52-53. There is insufficient antecedent basis for this limitation in the claim.

Claims 1, 3 and 5 contain the trademark/trade name Internet. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a specific type of network, the Internet, that is constantly changing/upgrading and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karmel (6,353,743) in view of Lobb et al (5,810,680).

Regarding claims 1-3, Karmel teaches a golfing aid system that includes a global positioning system device that pinpoints accurate positions of key landmarks on a golf course; cellular technology device providing mobile phone communication capabilities; a wireless internet link; a radio frequency transceiver for various types of communications on the golf course including with golfers and clubhouse; cellular packet data technology; a portable computer that transmits and receives GPS data; and operating system and software for the data communication (abstract; Fig. 1; Fig. 2; col. 3, lines 4-12; col. 6, lines 35-52; col. 7, lines 17-47). While Karmel teaches as a golf course position location device, Karmel is silent regarding the specific aspects of the device being hand-held with a touch screen. In an analogous golf location device, Lobb teaches a hand held device with a touch screen that also allows for tracing/input via a stylus (line 12 of abstract; col. 4, lines 52-55). It would have been obvious to a person of ordinary skill at the time of the invention to incorporate these features of Lobb into Karmel in order to make transportation and input of the data more convenient for the player. Further Lobb and Karmel do not explicitly disclose whether the radio frequency transceivers used in

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both systems are low power. However it would have been obvious to a person of ordinary skill in the art to incorporate this feature into Lobb and Karmel because it is well known in wireless data transmission.

Regarding claims 4-5, Karmel in view of Lobb teaches all the limitations of the claims as disclosed above. Lobb further teaches the features of allowing the golfer to input and trace course information via a stylus input (col. 10, lines 39-59; col. 4, lines 51-55). While Lobb teaches allowing user input and is functionally capable of allowing any specific type of user input according to various software programming, the reference is silent on the specific feature of prompting the user for a "Yes" or "No" response. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Lobb to make it more convenient for the user to make multiple data entries.

Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Albertshofer, Huston et al, Ohler et al, Karmel ('151), Stashko, Rudow et al, Brodie, Yokoyama et al, and Eschenbach.

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner, should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.



C. White
Patent Examiner



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